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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,592	10/31/2003	John A. Baumann	BO1 - 0196US	1654
60483	7590	08/14/2007	EXAMINER	
LEE & HAYES, PLLC 421 W. RIVERSIDE AVE. SUITE 500 SPOKANE, WA 99201			KERNS, KEVIN P	
			ART UNIT	PAPER NUMBER
			1725	
			MAIL DATE	DELIVERY MODE
			08/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/698,592

**Applicant(s)**

BAUMANN ET AL.

**Examiner**

Kevin P. Kerns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006 and 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 23-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this instance, the phrase that can be implied, "The present invention is directed to" should be replaced with "An".

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 contains the trademark/trade name TEFLON. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope

is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe PTFE (polytetrafluoroethylene) and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alber (US 2004/0120783) in view of Vierstraete (US 4,304,512).

Alber teaches a clamp for securing a work piece during a manufacturing operation, in which the clamp comprises a support arranged to at least partially surround a circumference defining a work area on the work piece, the support having a first end movable relative to a surface of the work piece; and at least one friction reducing element attached to the first end and disposed between the support and the work piece, with the friction reducing element applying a clamping pressure to the surface of the work piece, such that the clamp is capable of substantially surrounding the work area and a friction stir tool (see Figure 3). The friction reducing element comprises a self-lubricating, MoS<sub>2</sub> material and/or PTFE (paragraphs [0020-0023]). A mechanism is provided to move the support and maintain a specific pressure (paragraph [0057]). Alber does not specifically disclose that the friction reducing element is rotatable in operation.

However, Vierstraete teaches a clamp for securing one or more work pieces, in which the clamp comprises a support arranged to at least partially surround a circumference defining a work area on the work piece, the support having a first movable end and at least one friction reducing element attached to the first end and disposed between the support and the work piece, with the friction reducing element applying a clamping pressure to the surface of the work piece, such that the clamp is capable of surrounding the work area and a friction stir tool (see Figures 1 and 2). Hydraulics or pneumatics are employed for maintaining a specific pressure (column 3,

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lines 40-48). The friction reducing element comprises a self-lubricating element (column 2, lines 34-41), and ball or roller bearings, that enable the friction reducing element to be rotatable in operation, such that the rotatable operation is advantageous for providing optimum alignment with the means for compressing the work piece(s) (abstract; column 1, lines 4-14 and 45-51; column 2, lines 34-41 and 55-67; column 3, line 13 – column 4, line 9; and Figures 1 and 2).

It would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify the clamp for securing a work piece during a manufacturing operation, as disclosed by Alber, by using friction reducing element that is rotatable in operation, as taught by Vierstraete, in order to provide optimum alignment with the means for compressing the work piece(s) (Vierstraete; abstract; column 1, lines 4-14 and 45-51; and column 2, lines 34-41).

### ***Response to Amendment***

7. The declaration filed on November 27, 2006 under 37 CFR 1.131 is sufficient to overcome the Trapp et al. reference (US 2006/0102689), and all prior art rejections based on Trapp et al. are hereby withdrawn.

### ***Response to Arguments***

8. The examiner acknowledges the applicants' amendment received by the USPTO on April 5, 2007. The amendments overcome prior claim objections and rejections under 35 USC 112, 2<sup>nd</sup> paragraph. However, new abstract objections and a new 35

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USC 112, 2<sup>nd</sup> paragraph rejection have been raised in above sections 1 and 3. Since the declaration under 37 CFR 1.131 (received by the USPTO on November 27, 2006) overcomes all prior rejections based on the Trapp et al. reference, all previous prior art rejections under 35 USC 102(e) and 35 USC 103(a) are withdrawn. Claims 23-69 remain withdrawn from consideration as being drawn to non-elected inventions. Claims 1-22 remain under consideration in the application.

9. Applicants' arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection..

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on (571) 272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns *Kevin Kerns 8/9/07*  
Primary Examiner  
Art Unit 1725

KPK  
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August 9, 2007